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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/761,066

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Francisco Javier Guerra

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7590

02/05/2007

David W. Barman

1101 NE 176 Terrace

North Miami Beach, FL 33162

EXAMINER

GAKH, YELENA G

ART UNIT

PAPER NUMBER

1743

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/05/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/761,066

Applicant(s)

GUERRA ET AL.

Examiner

Yelena G. Gakh, Ph.D.

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 16-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15, drawn to an apparatus for detecting the presence of an illicit substance, classified in class 422, subclass 56.
  - II. Claims 16-19, drawn to a method for testing for the presence of an illicit substance, classified in class 436, subclass 169.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used for detecting any compound capable of reacting with colorimetric indicators, or it can be used for conducting synthesis with colorimetric detection.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with attorney David W. Barman on 01/30/07 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for colorimetric indicator suitable for testing the presence of an illicit substance, does not reasonably provide enablement for any other colorimetric indicator. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. There is no way to use the apparatus of claims 1-10 for detecting illicit substances if they comprise colorimetric indicators, which react with e.g. toxic compounds, rather than illicit drugs.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the expression "the test indicator solution", which does not make much sense, since it can be either a test solution, or an indicator. According to the specification (page 2, lines 10-11), this should be a test solution flowing to the colorimetric indicator.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-4, 6, 10-12 and 14** are rejected under 35 U.S.C. 102(e) as being anticipated by Craig (US 6,153,147).

Craig discloses an apparatus for detecting the presence of an illicit substance, specifically "a date rape drug", including GHB (4-hydroxybutanoic acid) and ROHYPNOL (flunitrazepam); the apparatus comprises a porous substrate and one or more colorimetric indicators embedded on said substrate (Figures, column 1). The porosity of the substrate allows the flow of the test

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solution to reach the indicator. The indicators suitable for the illicit drug test are bromocresol purple (Example 1, col. 13) and Zimmermann's reagent (Example 2, col. 14).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. **Claims 5, 13 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Craig in view of the well documented prior art admitted by the Applicants.

Although Craig does not specifically disclose "a date rape drug" Ketamine and colorimetric indicators platinum/potassium iodide and cobalt thiocyanate, the Applicants admit in the Background of the Invention, that the drug and the indicators mentioned above are well known, and therefore it would have been obvious for anyone of ordinary skills in the art to modify Craig's apparatus for detecting Ketamine and employing other well-known colorimetric indicators for illicit drugs, such as platinum/potassium iodide and cobalt thiocyanate.

13. **Claims 8-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Casterlin et al. (US 6,372,515 B1 or US Publication 2001/0012637) in view of Craig.

Casterlin discloses a test card for drugs of abuse “having the size and shape of a business card”. “A plurality of immunoassay test strips extend longitudinally from top to bottom at the card and are fastened side by side in parallel on one or both sides of the test card within the outline of the card. Each test strip is reactive to provide a visual indication in response to a particular drug of abuse. The test card thus provides for the simultaneous detection of multiple analytes. Processes are also disclosed for making the drug test card with test strips on one and both sides of the card”(Abstract, US 6,372,515 B1). The test card is used for detecting drugs in urine. In US 2001/0012637 Casterlin teaches contacting the business-type test card with several drops of urine (page 1, par. 0007).

Casterlin does not specifically disclose using his test card for detecting illicit drugs in beverages. Craig discloses the apparatus for detecting illicit drugs in beverages comprising the proper indicator embodied in the porous substrate.

It would have been obvious for anyone of ordinary skills in the art to modify Casterlin’s test business-type card for detecting illicit substances in beverages, using colorimetric indicators disclosed by Craig, because the illicit drugs of the instant invention are just another group of illegal drugs, and because Casterlin’s test “business-like” card can be easily used in public places.

14. **Claims 7-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Deegan (US Publication 2002/0132358 A1) in view of Craig.

Deegan discloses a caffeine testing device comprising “a test sheet constructed of a flexible and disposable material such as cloth, paper, or cardboard. Therefore, the test sheet may be constructed in the form of a **napkin**, coaster, or the like. The test sheet includes a reagent solution on which a consumer may place a sample of beverage, e.g. a few drops, for testing. The reagent section is impregnated with a reagent which, when reacted with caffeine, produces a characteristic chromogenic change which corresponds to a particular caffeine concentration” (col. 1, par. 0005).

Deegan does not disclose a device for testing illicit drugs.

Craig discloses the apparatus for detecting illicit drugs in beverages comprising the proper indicator embodied in the porous substrate.

It would have been obvious for anyone of ordinary skills in the art to modify Deegan's test sheet, including test napkin, for detecting illicit substances in beverages using colorimetric indicators disclosed by Craig, because caffeine is one of three illicit drugs disclosed by Craig, and it can be easily detected along with other illicit drugs with Deegan's napkin, which is especially convenient for use in public places.

### *Conclusion*

This is a continuation of applicant's earlier Application No. 09/945,908. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yelena G. Gakh, Ph.D. whose telephone number is (703) 306-5906. The examiner can normally be reached on 10:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Yelena G. Gakh

January 31, 2007

  
**YELENA GAKH**  
**PRIMARY EXAMINER**